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SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/575,361 12/24/95 CHANDRASEGARAN S 213779

EXAMINER

18M2/0303

CUSHMAN DARBY AND CUSHMAN
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EAST TOWER
1100 NEW YORK AVENUE NW
WASHINGTON DC 20005-3918

ART UNIT PAPER NUMBER

1814

DATE MAILED: 03/03/97

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

☒ This application has been examined ☒ Responsive to communication filed on 4/5/96 ☐ This action is made final.

A shortened statutory period for response to this action is set to expire 30 month(s) 30 days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- ☐ Notice of References Cited by Examiner, PTO-892.
- ☐ Notice of Draftsman's Patent Drawing Review, PTO-948.
- ☐ Notice of Art Cited by Applicant, PTO-1449.
- ☐ Notice of Informal Patent Application, PTO-152.
- ☐ Information on How to Effect Drawing Changes, PTO-1474.
- ☒ Added up copy of

Part II SUMMARY OF ACTION

1. ☒ Claims 1-26 are pending in the application.

Of the above, claims _____ are withdrawn from consideration.

2. ☐ Claims _____ have been cancelled.

3. ☐ Claims _____ are allowed.

4. ☐ Claims _____ are rejected.

5. ☐ Claims _____ are objected to.

6. ☒ Claims 1-26 are subject to restriction or election requirement.

7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.

8. ☐ Formal drawings are required in response to this Office action.

9. ☐ The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).

10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on _____, has (have) been ☐ approved by the examiner; ☐ disapproved by the examiner (see explanation).

11. ☐ The proposed drawing correction, filed _____, has been ☐ approved; ☐ disapproved (see explanation).

12. ☐ Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☐ been received ☐ not been received ☐ been filed in parent application, serial no. _____; filed on _____.

13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.

14. ☐ Other

EXAMINER'S ACTION

Restriction to one of the following inventions is required under 35 U.S.C. § 121:

I. Claims 1-8, drawn to a method for cloning restriction endonucleases, classified in Class 435, subclass 172.3.

II. Claims 9-26, drawn to a method for enzymatically inactivating a target DNA, classified in Class 435, subclass 91.1.

The inventions are distinct, each from the other because of the following reasons:

The two inventions claim two distinct, patentably distinct methods. There is nothing related in the two processes. Further, the method of Group II uses a "nuclease" whereas the method of Group I is directed to cloning a restriction endonuclease.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, as shown by their different classification, restriction for examination purposes as indicated is proper.

A telephone call was made to Ms. Ann Hobbs on February 27, 1997 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed.

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As a separate matter which has a separate response period, the communication filed on 4/5/96 is not fully responsive to the communication mailed 3/5/96 for the reasons set forth on the attached marked up raw sequence listing.

Since the response appears to be bona fide, but through an apparent oversight or inadvertence failed to provide a complete response, applicant is required to complete the response within a time limit of one (1) month from the date of this letter or within the time remaining in the response period of the communication mailed 3/5/96, whichever is the longer. 37 CFR 1.135(c).


NO EXTENSION OF THIS TIME LIMIT MAY BE GRANTED UNDER EITHER 37 C.F.R. 1.136(a) OR (b), BUT THE STATUTORY PERIOD FOR RESPONSE SET IN THE COMMUNICATION MAILED 3/5/96 MAY BE EXTENDED UP TO A MAXIMUM OF SIX (6) MONTHS UNDER 37 CFR 1.136.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles L. Patterson, Jr., Ph.D. whose telephone number is (703) 308-1834. The examiner can normally be reached on any day of the week from 7:30 AM until 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Wax, can be reached on (703) 308-4216. The fax phone number for this Group is (703) 305-7401.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Patterson
February 27, 1997


CHARLES L. PATTERSON, JR.
PRIMARY EXAMINER
GROUP 1800